

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

TIERRA INTELECTUAL BORINQUEN,  
INC.

Plaintiff,

v.

HTC CORPORATION et al.,

Defendants.

CASE NO. 2:13-cv-39-JRG

**CONSOLIDATED LEAD CASE**

TIERRA INTELECTUAL BORINQUEN,  
INC.

Plaintiff,

v.

TOSHIBA CORPORATION, et. al.,

Defendants.

CASE NO. 2:13-cv-47-JRG

JURY TRIAL DEMANDED

**UNOPPOSED MOTION FOR LEAVE TO AMEND  
DEFENDANTS' INVALIDITY CONTENTIONS**

Defendants Toshiba Corporation and Toshiba America Information Systems, Inc. ("Toshiba") respectfully request leave to amend Defendants' Invalidity Contentions for good cause pursuant to Patent Rule 3-6(b). Plaintiff does not oppose this motion.

Toshiba seeks leave to amend its invalidity contentions to identify three additional items of prior art relevant to obviousness of a single dependent claim — claim 4<sup>1</sup> of U.S. Patent No. 8,429,415 ("the '415 Patent"). These references are:

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<sup>1</sup> Claim 4 states "4. The computing device of claim 1, wherein the computing device comprises a handheld computing device."

Title	Date of Publication	Author	Publisher
CMOS Fingerprint Sensors Make PIN Codes Obsolete, Electronic Products (hard copy magazine) <a href="http://www.electronicproducts.com/Electromechanical_Components/CMOS_fingerprint_sensors_make_PIN_codes_obsolete.aspx">http://www.electronicproducts.com/Electromechanical_Components/CMOS_fingerprint_sensors_make_PIN_codes_obsolete.aspx</a>	August 1998 (hard copy) August 1, 1998 (online)	Alix L. Paultre	Hearst Business Communications, Inc.
FingerChip The thermal silicon chip Fingerprint sensor	March 2000		Atmel
FinderLoc System Frequently Asked Questions and Answers	1997		Harris Semiconductor

Toshiba has been carefully and diligently searching for prior art references since before the original Invalidity Contentions were due in October 2013. At that time, Toshiba and many other consolidated defendants were involved in searching for relevant prior art, but despite these diligent efforts, these three references were not discovered.

On May 28, 2014, Toshiba retained Alan Kramer as an expert to opine on invalidity of the asserted patents. Mr. Kramer has personal knowledge of the state of the art during the time of the alleged inventions, and had documents from that time period in his possession. Mr. Kramer discovered the three additional references on June 26, 2014, and Toshiba immediately produced them to the Plaintiff on June 27, 2014 (along with other materials discovered by Mr. Kramer).

On July 6, 2014, Toshiba informed Plaintiff of its desire to amend its invalidity contentions to identify these three additional items of prior art in the obviousness combinations for claim 4 of the '415 Patent. Plaintiff has since confirmed that it does not oppose this motion.

Toshiba therefore respectfully requests that the Court grant this Unopposed Motion for Leave to Amend Defendants' Invalidity Contentions.

Dated: July 8, 2014

Respectfully submitted,

/s/ Katie J.L. Scott

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**ATTORNEYS FOR DEFENDANTS  
TOSHIBA CORPORATION AND  
TOSHIBA AMERICA INFORMATION  
SYSTEMS, INC.**

**CERTIFICATE OF CONFERENCE**

I certify that I have complied with the meet and confer requirement in Local Rule CV-7(h) and that this motion is unopposed.

By: /s/ Katie J.L. Scott  
Katie J.L. Scott

**CERTIFICATE OF SERVICE**

I certify that this document was filed electronically pursuant to Local Rule CV-5(a) on July 8, 2014. Pursuant to Local Rule CV-5(a)(3)(A), this electronic filing acts to electronically serve all counsel who have consented to electronic service via the Court's CM/ECF System.

By: /s/ Katie J.L. Scott  
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